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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,084	11/19/2003	Christopher J. Cookson	3053-066	9419

22440 7590 02/13/2007  
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NEW YORK, NY 100160601

EXAMINER
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PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,084	<b>Applicant(s)</b> COOKSON ET AL.	
	<b>Examiner</b> Aristotelis M. Psitos	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' response of 11/24/06 has been considered with the following results.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations as defined in claims 17-22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot

Art Unit: 2627

readily find support for the newly introduced phrase defining the indicia as recited in dependent claims 17 and 20. Similarly, the limitations with respect to dependent claims 18,19,21 and 22.

As far as the claim recite positive limitations, the following art rejections are made.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1,3, 5-8,10,11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murai et al considered with Masuda et al and all further considered with Hioki et al.

The following analysis is made:

Art Unit: 2627

Claim 1

Murai et al

An optical data disc comprising: See abstract, title and description of figs.  
a first side and a second side, 3-6  
each side including at least a first data  
layer,  
wherein data is arranged on the data layer  
of said first side along a first spiral  
oriented in a first direction when viewed  
on said first side, and data is arranged on the  
data layer of said second side along a second  
spiral oriented in a direction opposite that  
of said first spiral when viewed on said second side,  
so that a read head that is adjacent  
to one side can read the data thereon when  
the disc is rotated in one direction and  
when adjacent to the other side can read the data  
thereon when the disc is rotated in  
the other direction, and

direction indicia disposed on at least see secondary references - below  
one of said first and second sides,  
said direction indicia being machine  
readable and being indicative of the direction in  
which the disc must be rotated to allow data  
to be read from at least one side.

Art Unit: 2627

As analyzed above, the Murai et al system disclose an optical record having a first and second side, in which at least one recording layer is contained thereon. The desired "so that" phrase of claim 1 inherently follows.

With respect to the direction indicia – no such information is so contained.

The secondary references to Masuda et al and Hiroki et al discuss the ability in this environment of providing for appropriate "control" indicia – signal/ that indicate which side is "up", or the first side. See the discussion with respect to element 94 in figure 2 and the discussion with respect to figure 3 respectively.

It would have been obvious to modify the base system of Murai et al and modify such with the above noted teachings so as to provide for appropriate "directional indicia" that is "machine readable". Such control information provides for an automatic playback of the media as desired.

The limitations of claims 1 and 7 are hence met.

With respect to claims 3 and 10, lead in area is provided. Because the indicium in Masuda et al is separate from such, this limitation is met.

With respect to claim 5 this refers to the data found on the record medium. Such data is present in the above references.

With respect to claims 6 and 8, such is met by the above combination of references.

With respect to claim 11, the special section is interpreted as that found in the secondary reference to Masuda et al.

With respect to claim 13 such is present.

### ***Response to Arguments***

Applicant's arguments filed 11/24/06 have been fully considered but they are not persuasive. As indicated above and with respect to the secondary references, as noted a machine readable mark/indicia is indeed depicted in the Masuda et al reference – figure 2, mark 94 which indicates a bottom side. As noted in the Hiroki et al reference, the bottom side B, is rotated in a different direction than that of side A (counter from that of side A).

Art Unit: 2627

Hence the examiner concludes that one of ordinary skill in the art would be motivated to use these secondary teachings in order to modify the base reference so that a dual sided disc (secondary references) would provide for the appropriate indicia so that the proper rotation is effected.

2. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 7 as stated in paragraph 1 above, and further in view of the acknowledge prior art of figure 1.

The limitations of claims 2 and 9 are drawn to the acknowledged prior art multi-layered media known.

The description of the acknowledged prior art recognizes the claimed limitations.

It would have been obvious to modify the above noted references to include such multiple layers; motivation is as acknowledged – providing increased data storage.

### ***Response to Arguments***

Applicant's arguments filed 11/24/06 have been fully considered but they are not persuasive. The dependent claims fall with their respective parent claim.

3. Claims 4, 12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 7 as stated in paragraph 1 above, and further in view of Official notice.

With respect to claims 4 and 12, as interpreted, the above combined references provide for the ability of having an appropriate control signal – as recognized by the Hioki et al reference on each side of the record medium. As interpreted above, the special section is interpreted as that of the element 94 in Masuda et al.

As well known in this environment, the use of bar codes, and the BCA for appropriate control information is well known and Official notice is taken thereof.

The ability of using such well known techniques – BCA, bar codes, in the appropriate location – and designate such as a “third” spiral” is considered met by the above combined teachings.

With respect to the limitations of claim 14 such is met when the above references are relied upon.

### ***Response to Arguments***

Applicant's arguments filed 11/24/06 have been fully considered but they are not persuasive. The dependent claims fall with their respective parent claim.

4. Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 7 above, and further in view of Gotoh et al. Note the disclosure with respect to the reverse side identifier.

It would have been obvious to modify the base system as relied upon above with respect to the independent claims and modify such with a plural symbol indicia as taught by the Gotoh et al reference, motivation is to use already in use formats for identifiers.

5. Claims 18, 19, 21, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 17 and 20 above, and further in view of modern day compasses.

As known to those in the arts, modern day compasses have a numerical format that increases in one direction and decreases in the other direction (0 – 360, 360 – 0).

Hence the ability of formatting symbols to increase in one direction and decrease in the other is considered an obvious modification.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 2627

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to O'Hara et al, Ito et al and Kawamura et al can be relied upon in place of the base reference to Murai et al for discloses an optical record having the appropriate directional limitations.

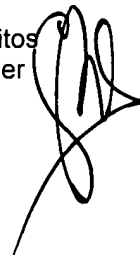
The Bartholet et al document is cited as illustrative of an alternative side/directional indicia teaching.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2627



AMP